



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,167	03/26/2004	Richard Stolls	P-001	1998

28752 7590 06/27/2006
LACKENBACH SIEGEL, LLP
LACKENBACH SIEGEL BUILDING
1 CHASE ROAD
SCARSDALE, NY 10583

EXAMINER

HOGUE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
----------	--------------

3611

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/811,167	Applicant(s) STOLLS ET AL.	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,9,10,25,26 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7,8,11-15,22-24,27-30 and 36-39 is/are rejected.
- 7) ☒ Claim(s) 16,17 and 31-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Species II in the reply filed on April 3, 2006 is acknowledged. The traversal is on the ground(s) that there are no patentably distinct species shown, but rather that the drawings are shown in a "construction-sequence" form. This is not found persuasive because Fig. 1 shows an embodiment having wheels and internal lighting; Fig. 2 shows an embodiment having no wheels and internal lighting; and Fig. 3 shows an embodiment having no wheels and external lighting. Thus, the three Figs. do show mutually-exclusive embodiments. Further, Applicant's statement that only a single embodiment has been disclosed does not correspond to the Specification, in which the phrase "According to another embodiment" occurs 38 times. Still further, in the Brief Description of the Drawings, Fig. 1 is described as being "according to one embodiment," Fig. 2 is described as being a view "of one embodiment," and Fig. 3 is described as being a view of "an alternative embodiment."

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 4-6, 9, 10, 21, 25, 26 and 35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 3, 2006.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "automated means for receiving and storing a programmed input," the "control means," the "power distribution means" (claims

Art Unit: 3611

12 and 28) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 14 and 30 are objected to because of the following informalities: In claim 14, line 7, it appears that “said” or “the” should be inserted before “frame member” on line 7. In claim 30, line 6, it appears that “said” or “the” should be inserted before “frame member”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 3611

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 12, 13 and 28 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See the above objection to the drawing.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the phrase “each said opening in combination with and said bounded inner volume” is not understood.

Regarding claim 14, the phrase “said frame member includes said plurality of rigid framing members said support footing member” is not understood.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3611

9. Claims 1, 8, 11, 15, 18 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Dyar (5,003,716).

Dyar discloses a support frame member **39** projecting from an external support surface **11** and defining an inner volume; a flexible covering member **42** including means for removably covering the frame member and bounding the inner volume therein; the support frame supporting the flexible covering member and defining at least one visual plane on the covering member; the display apparatus enabling the positioning of at least one visual image on the covering member proximate the visual plane and available for visual approach by an external viewer; and at least a lighting assembly **46** positioned within the bounded inner volume, whereby a light projected from the lighting assembly illuminates the covering member **42**.

Regarding claim 8, the frame has openings at both ends. These ends can be called “top” and “bottom” depending on the frame of reference.

Regarding claim 11, see Fig. 5 and part **45**.

Regarding claim 15, cables **19** are used to tension the cover, and these cables extend across part of the openings at the ends of the frame.

Regarding claim 37, parts **39** constitute side supports joining top and bottom sections **22**.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-3, 7, 8, 11, 18-20, 22-24, 27, 29 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theobald (5,347,737) in view of Dyar (5,003,716).

See Fig. 6. Theobald discloses a support frame member **16** projecting from an external support surface (the ground) and defining an inner volume; a flexible covering member **14** including means for removably covering the frame member and bounding the inner volume therein; the support frame supporting the flexible covering member and defining at least one visual plane on the covering member; the display apparatus enabling the positioning of at least one visual image on the covering member proximate the visual plane and available for visual approach by an external viewer. However, Theobald does not disclose a lighting assembly within the inner volume. Dyar teaches that it was known in the art to provide a lighting assembly inside a sign with a flexible covering. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sign disclosed by Theobald with a lighting assembly, as taught by Dyar, in order to make the sign readable at night.

Regarding claims 3 and 23, Dyar discloses a fixed lighting unit.

Regarding claims 7 and 24, Theobald discloses rigid framing members.

Art Unit: 3611

Regarding claims 11 and 27, see column 4, lines 18-29, of Theobald.

Regarding claim 20, see column 3, lines 50-65, of Theobald.

Regarding claim 29, because the sign is mobile, the fixed lighting unit is also mobile.

Regarding claim 38, Theobald discloses a plurality of frame members. Although each of these appears to be the same length, the claim does not specify that the first and second lengths are different.

13. Claims 12, 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theobald (5,347,737) in view of Dyar (5,003,716) as applied to claim 3 above, and further in view of Dowling et al. (2002/0038157).

Theobald discloses the invention substantially as claimed, as set forth above. Because the sign contains an electric light, there must inherently be a power distribution means present. However, Theobald does not disclose an automated means for receiving and storing a programmed input and driving a control means of the lighting assembly. Dowling et al. teaches that it was known in the art to provide such a means for controlling a lighting system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lighting system disclosed by Theobald, as modified, with a control system, as taught by Dowling, in order to create an attention-getting lighting effect.

Regarding claim 13, because the sign is mobile, the fixed lighting unit is also mobile.

14. Claims 14 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theobald (5,347,737) in view of Dyar (5,003,716) as applied to claim 7 above, and further in view of Johnson (5,634,286).

Theobald discloses the invention substantially as claimed, as set forth above. However, Theobald does not disclose a support footing member and a plurality of spacing members spacing the support footing member from the frame member. Johnson teaches that it was known in the art to provide a sign with a support footing member 70 and a plurality of spacing members 72. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sign disclosed by Theobald with a support footing member and a plurality of spacing members, as taught by Johnson, in order to improve the aesthetic appearance of the sign.

Allowable Subject Matter

15. Claims 16, 17 and 31-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C Hoge
Primary Examiner
Art Unit 3611

gch